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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,992	07/02/2001	Anna Belle Williams	M-9864 US	1188
33438	7590	09/01/2005	EXAMINER	
HAMILTON & TERRILE, LLP			HECK, MICHAEL C	
P.O. BOX 203518			ART UNIT	
AUSTIN, TX 78720			PAPER NUMBER	
			3623	

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/896,992

**Applicant(s)**

WILLIAMS ET AL.

**Examiner**

Michael C. Heck

**Art Unit**

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16, drawn to identifying a component or set of components for an assembled product, classified in class 705, subclass 7.
  - II. Claims 17-20, drawn to determining a benchmark cost, classified in class 705, subclass 10.
  - III. Claim 21, drawn to determining best bill of material, classified in class 705, subclass 29.
  - IV. Claims 22 and 24, drawn to manufacturing and assembling a computer system, classified in class 705, subclass 29.
  - V. Claim 23, drawn to designing a computer system, classified in class 705, subclass 8.
  - VI. Claims 25-35, drawn to managing purchasing information and forecasting material requirements, classified in class 705, subclass 10.
  - VII. Claims 36-46, drawn to determining attributes of components, classified in class 705, subclass 8.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as identifying a second source of supply for a component. See MPEP § 806.05(d).

Art Unit: 3623

3. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as identifying a second source of supply for a component. See MPEP § 806.05(d).

4. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as identifying a second source of supply for a component. See MPEP § 806.05(d).

5. Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as identifying a second source of supply for a component. See MPEP § 806.05(d).

6. Inventions I and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as identifying a second source of supply for a component. See MPEP § 806.05(d).

7. Inventions I and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as identifying a second source of supply for a component. See MPEP § 806.05(d).

8. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

Art Unit: 3623

shown to be separately usable. In the instant case, invention II has separate utility such as benchmarking performance to world-class standards. See MPEP § 806.05(d).

9. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as benchmarking performance to world-class standards. See MPEP § 806.05(d).

10. Inventions II and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as benchmarking performance to world-class standards. See MPEP § 806.05(d).

11. Inventions II and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as benchmarking performance to world-class standards. See MPEP § 806.05(d).

12. Inventions II and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as benchmarking performance to world-class standards. See MPEP § 806.05(d).

13. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as determining the lowest cost supplier. See MPEP § 806.05(d).

Art Unit: 3623

14. Inventions III and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as determining the lowest cost supplier. See MPEP § 806.05(d).

15. Inventions III and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as determining the lowest cost supplier. See MPEP § 806.05(d).

16. Inventions III and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as determining the lowest cost supplier. See MPEP § 806.05(d).

17. Inventions IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as determining the processes to use to manufacture and assemble a computer system. See MPEP § 806.05(d).

18. Inventions IV and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as determining the processes to use to manufacture and assemble a computer system. See MPEP § 806.05(d).

Art Unit: 3623

19. Inventions IV and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as determining the processes to use to manufacture and assemble a computer system. See MPEP § 806.05(d).

20. Inventions V and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as designing a computer system based on manufacturability and cost. See MPEP § 806.05(d).

21. Inventions V and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as designing a computer system based on manufacturability and cost. See MPEP § 806.05(d).

22. Inventions VI and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as managing the purchasing function of a business. See MPEP § 806.05(d).

23. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-VII, restriction for examination purposes as indicated is proper.

Art Unit: 3623

24. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Groups I and III-VII, restriction for examination purposes as indicated is proper.

25. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Groups I-II and IV-VII, restriction for examination purposes as indicated is proper.

26. Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Groups I-III and V-VII, restriction for examination purposes as indicated is proper.

27. Because these inventions are distinct for the reasons given above and the search required for Group V is not required for Groups I-IV and VI-VII, restriction for examination purposes as indicated is proper.

28. Because these inventions are distinct for the reasons given above and the search required for Group VI is not required for Groups I-V and VII, restriction for examination purposes as indicated is proper.

29. Because these inventions are distinct for the reasons given above and the search required for Group VII is not required for Groups I-VI, restriction for examination purposes as indicated is proper.



***Conclusion***

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 3623

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael C. Heck whose telephone number is (571) 272-6730. The Examiner can normally be reached Monday thru Friday between the hours of 8:30am - 4:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 273-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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Or faxed to:

**(571) 273-8300**

[Official communications; including After Final communications labeled "**Box AF**"]

**(571) 273-6730**

[Informal/Draft communication, labeled "**PROPOSED**" or "**DRAFT**"]

*MCH*  
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25 August 2005

*Susanna Diaz*  
**SUSANNA M. DIAZ**  
**PRIMARY EXAMINER**

*AU 3623*